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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,614	10/17/2003	Kelcy L. Warren	ETG:1003RCE	2439
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CHALKER FLORES, LLP			EXAMINER	
2711 LBJ FRWY			BORISSOV, IGOR N	
Suite 1036				
DALLAS, TX 75234			ART UNIT	PAPER NUMBER
			3628	
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			08/18/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/688,614

**Applicant(s)**

WARREN ET AL.

**Examiner**

IGOR BORISSOV

**Art Unit**

3628

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 June 2010.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-13, 17-30, 33-43, 47-66, 69-78 and 82-94 is/are pending in the application.  
4a) Of the above claim(s) 20-29, 50-65, 85-94 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 4-13, 17-19, 30, 33-43, 47-49, 66, 69-78 and 82-84 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Remarks***

Office Action of 12/09/2009 has been issued erroneously and has been vacated.

### ***Response to Amendment***

Amendments received on 08/03/2009 and 06/09/2010 are acknowledged and entered. Claims 20-29, 50-65, 85-94 have been withdrawn. Claims 2-3, 14-16, 31-32, 44-46, 67-68, 79-81 have been canceled. Claims 1, 4-13, 17-30, 33-43, 47-66, 69-78, and 82-94 are currently pending in the application.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4-13, 17-19, 30, 33-43, 47-49, 66, 69-78, and 82-84 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 1 recites the limitation: "and (2) sending one or more signals to the one or more switches or couplings" in line 17. There is insufficient antecedent basis for this limitation in the claim. Same reasoning applied to the remaining independent claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 4-13, 17-19, 30, 33-43, 47-49, 66, 69-78, and 82-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mistr, Jr. (US 6,153,943) in view of MacKay (US 2005/0072164) or Clements (US 3,943,374), and further in view of Aasen et al. (US 4,802,100).**

Mistr, Jr. (hereinafter Mistr) teaches a method, system and a computer-readable medium having instructions embedded therein for causing a computer to implement said method for selecting a power source to a device, comprising:

Claims 1, 30 and 66,

(a) analyzing market and operational data related to the two or more available power sources, and the device or delivery point (Fig. 1 items 35 and 36; C. 13, L. 6-11, 21, 31-32; C. 17, L. 12-14); wherein the two or more available power sources are connected to the device or delivery point via one or more switches or couplings;

(b) selecting the power source for the device or delivery point from the two or more available power sources based on a set of financial parameters (C. 13, L. 37-40);

(c) whenever the device or delivery point is not already connected to the selected power source, determining whether it is profitable to switch the device or delivery point to the selected power source (based on historical operating data, current operating data, contract data, market data and financial data), sending one or more signals to switch the device or delivery point to the selected power source (operating system by a computer in an automatic mode indicates "signal" feature; C. 13, L. 37-44).

While Mistr teaches two or more available power sources including a mechanical source ( i.e. a power generator/mechanical source; Fig. 1, item 35), Mistr does not explicitly teach that said two or more available power sources comprise two or more mechanical sources.

Either MacKay or Clements disclose a plurality of mechanical sources (a motor/generator and a turbine) that are connected to a device (a load) via one or more couplings (MacKay, Figs. 1-5, [0029]; Clements, Fig. 1, Abstract).

Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify Mistr, Jr. to include said two or more available power sources (Fig. 1 items 35 and 36) comprise two or more mechanical sources, as disclosed in either MacKay or Clements, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396. Furthermore, it would have been recognized that applying additional power generator/mechanical source to Mistr would have yielded predictable results because the level of ordinary skill in the art demonstrated by the reference applied shows the ability to incorporate such power generator/mechanical source. Further, applying additional power generator/mechanical source to Mistr, Jr. would have been recognized by one of ordinary skill in the art as resulting in an improved system that would allow more reliable and versatile operation. *KSR*, 127 S.Ct. at 1740, 82 U SPQ2d at 1396.

Also, a combination of Mistr and either MacKay or Clements does not specifically teach determining whether a user has overridden switching the device or delivery point to the selected power source; and that said sending one or more signals to switch the device or delivery point to the selected power source is conducted whenever the user has not overridden switching the device or delivery point to the selected power source.

Aasen et al. (hereinafter Aasen) teaches a method and system for selecting a power source to a device, comprising: (a) analyzing market and operational data related to the two or more available power sources, and the device or delivery point; (b) selecting the power source for the device or delivery point from the two or more available power sources based on a set of financial parameters; and (c) sending one or more signals to switch the device or delivery point to the selected power source whenever the device or delivery point is not already connected to the selected power source, wherein system control can be implemented via a manual mode, thereby suggesting "overridden" feature (C. 6, L. 27-35; C. 10, L. 55-59; C. 15, L. 58 - C. 16, L. 22).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination to include determining whether a user has overridden switching the device or delivery point to the selected power source, as suggested in Aasen, because it would advantageously allow to reprogram the system for business benefit. Furthermore, in this case, each of the elements of the cited references combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results. See *Sakraida*, 425 U.S. at 282, 189 USPQ at 453. Therefore, Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Claims 4, 33 and 69. Aasen teaches updating a display (Fig. 3). KSR, 82 USPQ2d at 1396.

Claims 5, 18, 19, 34-36 and 70. Mistr teaches receiving market and operational data related to the two or more available power sources, and the device or delivery point (C. 13, L. 6-11, 21, 31-32; C. 17, L. 12-14).

Claims 6 and 71. Mistr teaches repeating steps (a), (b) and (c) (monitoring said market and operational data in real time indicates "repeating" feature; C. 13, L. 31-37).

Claims 7, 8, 37, 38, 72 and 73. Mistr teaches repeating steps (a), (b) and (c) (monitoring and calculating in real time), thereby suggesting that said repeating of said steps is conducted periodically. The motivation to modify the reference would be to employ the low cost slow processors and network connection.

Claims 9-12, 39-42, 74-77. Mistr teaches said method and system, wherein the market and operational data is selected from the group consisting of historical operating data, current operating data, contract data, market data and financial data.

Claims 13, 43 and 78. Aasen teaches that the one or more signals are manually sent or implemented. KSR, 82 USPQ2d at 1396.

Claims 17, 47 and 82. The combination teaches that the device is selected from the group consisting of a compressor and a pump.

Claims 18, 19, 48, 49, 83 and 84. The combination teaches multi-source systems.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 4-13, 17-19, 30, 33-43, 47-49, 66, 69-78, and 82-84 have been considered but are moot in view of the new ground(s) of rejection. If Applicant has questions regarding Examiner's position regarding the recited limitations, Applicant cordially invited to contact Examiner to resolve all issues.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Igor N. Borissov/

Primary Examiner, Art Unit 3628

08/15/2010